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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,924	04/26/2000	John Albert Kembel	10351-0005	1659

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Innovation Management Sciences  
47787 Fremont Boulevard  
Fremont, CA 94538

EXAMINER
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AVELLINO, JOSEPH E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 02/13/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/558,924

Applicant(s)

KEMBEL ET AL.

Examiner

Joseph E. Avellino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-20 are presented for examination.

#### ***Specification***

2. A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the specification does not conform to 37 CFR 1.52(1)(ii) which states the top margin of the specification must be at least two (2) inches. A substitute specification in conformance with at least a top margin of two (2) inches is necessary for this case to go to allowance.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-7, and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al. (USPN 5,740,549) (cited by applicant in IDS) (hereinafter Reilly).

5. Referring to claim 1, Reilly discloses a method of tracking distributed content within a computer network, said method comprising the steps of:

identifying the delivery of a set of Network Information Monitors (NIMs) (sprites and actors, see rejection below) (e.g. abstract; col. 10, line 19 to col. 11, line 5);

tracking information about each NIM within said set of NIMs, said information including:

an identifier for said selected NIM (col. 7, lines 45-67); and

determining from said information sub-sets of NIMs that are displayed simultaneously (col. 7, line 65 to col. 8, line 4).

Although Reilly does not specifically disclose that tracking information is collected when the user opens and closes a selected NIM, Reilly does state that profile data including "viewing preferences" (abstract) is collected. This would lead one of ordinary skill in the art to determine that tracking times that a user is using the system can be collected and used for statistical purposes, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide for tracking the usage of the program for enhanced statistical purposes and marketing strategies.

6. Referring to claim 2, Reilly discloses tracking information is selected from the group comprising a home NIM download event, a NIM download event, a NIM display event, a browser click-through event, and a page-view event (col. 7, line 21 to col. 8, line 18). The Office takes "tracking information" to mean any data collection or event which will cause an update of a profile.

7. Referring to claim 3, Reilly discloses tracking information is selected from the group comprising a NIM installation event (selecting more (sub)categories to monitor), a home NIM startup event, a transient mode event, a shared NIM received event, and a shared NIM pack received event (col. 9, lines 35-63; col. 12, lines 25-45).

8. Referring to claim 4, Reilly discloses constructing a statistical database to track individual events executed by a plurality of users that receive NIMs (Figure 4 and pertinent portions of the disclosure).

9. Referring to claim 5, Reilly discloses constructing a content database to characterize the content associated with a set of NIMs (Figure 8; col. 11, line 64 to col. 12, line 19).
10. Referring to claim 6, Reilly discloses using subsets of NIMs to create packs of NIMs (col. 9, lines 59-62).
11. Referring to claim 7, Reilly discloses targeting an advertisement to a single user based upon said subsets of NIMs (Figures 8-9; col. 12, line 6-56).
12. Claims 10-20 are rejected for similar reasons as stated above.

Claims 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly in view of Hunt et al. (USPN 5,893,091) (cited by applicant in IDS) (hereinafter Hunt).

13. Referring to claim 8, Reilly discloses a method of tracking distributed content as stated in the claims above. Reilly does not specifically disclose dynamically determining in real-time subsets of NIMs that are displayed simultaneously, however Hunt discloses dynamically determining in real-time subsets of NIMs that are displayed simultaneously

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(col. 4, line 56 to col. 5, line 4; col. 11, lines 25-35). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Hunt with Reilly to reduce network congestion by using Multicast IP addressing to update news databases on client machines.

14. Referring to claim 9, Reilly discloses a method of tracking distributed content as stated in the claims above. Reilly does not specifically disclose determining sub-sets of NIMs that are delivered to a single user, however Hunt discloses determining sub-sets of NIMs that are delivered to a single user (col. 4, line 56 to col. 5, line 4). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Hunt with Reilly to reduce network congestion by using Multicast IP addressing to update news databases on client machines.

### ***Response to Arguments***

15. Applicant has requested the objection to the specification be held in abeyance until such time as the matters of patentability have been resolved. The objection will be held in abeyance but a substitute specification is required for this case to go to issue.

16. Applicant's arguments filed January 5, 2004 have been fully considered but they are not persuasive.

17. Applicant argues in substance that, (1) Reilly fails to disclose or suggest a "networked information monitor," (NIM) which was referred to as "a fully configurable frame with one or more controls; the frame through which content is optionally presented" in the specification, (2) Reilly does not disclose anything resembling a set of NIMs since the home NIM coordinates the activities of all other NIMs accessed by the user and allows the user to review, package and distribute multiple sources of media.

18. As to point (1), in light of the definition of a "networked information monitor," as "a fully configurable frame with one or more controls; the frame through which content is optionally presented" in the specification, the term "fully configurable frame" can be broadly construed as "a window with configurable settings". Taking this definition into mind, attention is turned to Figure 7a and pertinent portions of the disclosure. The system allows the user to customize the size, fonts and relative locations of the windows (in the reference called "sprites"). These "sprites" allow the user to define the content source to display, how to generate the image of the "actor" (the representation of a "sprite"). By this rationale the rejection is maintained.

19. As to point (2), In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a home NIM coordinating the activities of all other NIMs accessed by the user and allows the user to review, package and distribute multiple sources of media) are not recited in the rejected claim(s). Although the claims are interpreted in



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light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (703) 305-7855. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (703) 308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

JEA  
February 12, 2004



**DAVID WILEY**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100